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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,431	12/13/2001	Christopher M. Benson	9903	5732

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EXAMINER

LE, DANH C

ART UNIT PAPER NUMBER

2683

DATE MAILED: 07/29/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,431

Applicant(s)

BENSON, CHRISTOPHER M.

Examiner

DANH C LE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 1/13/04 has been considered by the Examiner and made of record in the application file.

Specification

2. The disclosure is objected to because of the following informalities:

a) On page 6, line 11, replace "12" with -10—after "store" in order to match the reference number in figure 1; and

b) On page 9, line 4, replace "10" with -12—after "system" in order to match the reference number in figure 2.

Appropriate correction is required.

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

On page 8, line 23, www.bluetooth.com need to remove.

On page 9, line 2, www.bluetooth.com need to remove.

Double Patenting

3. Claim 4 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 3. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in

wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. **Claims 1, 2, 5 are rejected under 35 U.S.C. 102(a) as being anticipated by Saito (US 2001/0014870).**

As to claim 1, Saito teaches a method of providing an advertisement for a store to a prospective customer (figure 1) comprising the steps of:

compiling an advertisement (a cryptographic, figure 4, processing unit 206 and paragraph 0085 for carry out cryptographic processing regarding the electronic coupon);

formatting the advertisement into a radio signal having a radio transmission protocol that is receivable by a personal device of a prospective customer, the personal device having a radio receiver enabled to receive the transmission protocol signal (paragraph 128-130, the radio base station 102 in figure 1, first transmits a display format inquiry message for inquiring which display contents description format can be displayed on a display screen of the portable terminal 105, to the portable terminal 105); and

transmitting the radio signal from the store (paragraph 128-130).

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As to claim 2, Saito teaches the method of claim 1, wherein the step of transmitting the radio signal from the store includes transmitting the radio signal from the store to within a perimeter of the store (paragraph 0054, 0055, 0058).

As to claim 5, Saito teaches the method of claim 1, wherein the step of formatting utilizes Bluetooth radio transmission protocol, and the radio receiver of the personal device is Bluetooth enabled (paragraph 60).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 3, 4, 7-11, 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito in view of Waters (US 2002/0008626).**

As to claim 3, Saito teaches the method of claim 2, wherein the step of transmitting the radio signal from the store to within a perimeter of the store includes transmitting the radio signal from the store to within a perimeter.

Saito fails to teach the perimeter is outside of the store. Waters teaches the perimeter is outside of the store (figure 1, zone 15, col.6, lines 39-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Waters into the system of Saito in order to transmit an

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advertising display intended for tourist and motorists outside the store (as suggested by Waters at column 6, lines 39-54).

As to claim 4, the limitation of the claim is the same limitation of claim 3; therefore, the claim is interpreted and rejected as set forth as claim 3.

As to claim 7, Saito teaches an apparatus for providing an advertisement to a prospective customer (figure 4) comprising:

a storage device operative to store an advertisement (figure 4, 205);

a transmitter in communication with the storage device and operative to receive the advertisement from the storage device, the transmitter further operative to format the advertisement into a radio signal having a radio transmission protocol that is receivable by a personal device of a prospective customer having a radio receiver enabled to receive the transmission protocol signal (figure 4 and paragraph 128-130, "the radio base station 102 first transmits a display format inquiry message for inquiring which display contents description format can be displayed on a display screen of the portable terminal 105, to the portable terminal 105"); and

Saito fails to teach an antenna in communication with the transmitter and operative to transmit the radio signal from the store. Waters teaches an antenna in communication with the transmitter and operative to transmit the radio signal from the store (figure 2, 14 with antenna symbol). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Waters into the system of Saito in order to send electronic coupon to the mobile inside and outside the store.

As to claim 8, Saito teaches the apparatus of claim 7, wherein the transmitter and antenna are operative to transmit the radio signal from the store to within a perimeter of the store (paragraph 58).

As to claim 9, the limitation of the claim is the same limitation of claim 3; therefore, the claim is interpreted and rejected as set forth as claim 3.

As to claim 10, Saito teaches the apparatus of claim 8, wherein the perimeter of the store comprises a distance inside of the store (figure 17, 18 and paragraph 231-233).

As to claim 11, Saito teaches the method of claim 1, wherein the step of formatting utilizes Bluetooth radio transmission protocol, and the radio receiver of the personal device is Bluetooth enabled (paragraph 60).

As to claim 13, Saito teaches the system for store advertising (figure 4) comprising:

a storage device operative to store a store advertisement (figure 4, 205);

a transmitter located at the store and in communication with the storage device and operative to receive the advertisement from the storage device, the transmitter further operative to format the advertisement into a radio signal having a radio transmission protocol that is receivable by a personal device of a prospective customer having a radio receiver enabled to receive the transmission protocol signal (paragraph 128-129).

a receiver located at the store and operative to receive an incoming radio signal of the radio transmission protocol from the personal device of the prospective customer (figure 2, 121 and paragraph 66), and

Saito fails to teach an antenna located at the store and in communication with the transmitter and the receiver, the antenna operative to transmit the radio signal from the store and receive the incoming radio signal from the personal device. Waters teaches an antenna located at the store and in communication with the transmitter and the receiver, the antenna operative to transmit the radio signal from the store and receive the incoming radio signal from the personal device (figure 1 and 2, 14 with antenna symbol).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Waters into the system of Saito in order to increase the coverage area and send electronic coupon to the mobile inside the store at the same time to the tourist and motorist outside the store.

As to claim 14, the limitation of the claim is the same limitation of claim 8; therefore, the claim is interpreted and rejected as set forth as claim 8.

As to claim 15, the limitation of the claim is the same limitation of claim 3; therefore, the claim is interpreted and rejected as set forth as claim 3.

As to claim 16, the limitation of the claim is the same limitation of claim 10; therefore, the claim is interpreted and rejected as set forth as claim 10.

As to claim 17, Saito teaches the method of claim 1, wherein the step of formatting utilizes Bluetooth radio transmission protocol, and the radio receiver of the personal device is Bluetooth enabled (paragraph 60).

8. Claims 6, 12, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito in view of Treyz et al (US 6,587,835).

As to claim 6, Saito teaches the method of claim 5, Saito fails to teach the step of formatting includes the step of providing an interactive component to the radio signal. Treyz teaches the step of formatting includes the step of providing an interactive component to the radio signal (col.66, lines 55-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Treyz into the system of Saito in order to select the advertisement and responding to on-screen options on the handheld ((as suggested by Treyz at column 66, lines 55-67).

As to claim 12, the limitation of the claim is the same limitation of claim 6; therefore, the claim is interpreted and rejected as set forth as claim 6.

As to claim 18, the limitation of the claim is the same limitation of claim 6; therefore, the claim is interpreted and rejected as set forth as claim 6.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Nohara et al (US 20020034954) teaches an information distribution system.

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B. Shioda et al (US 20020077910) teaches an advertising information providing system.

C. Rigo et al (US 2002/0049535) teaches a wireless interactive voice-actuated mobile telematics system.

D. Moon (US 6,545,596) teaches presenting information to mobile targets.

E. Hiltunen et al (US 6,754,484) teaches short messaging using information beacons.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANH C LE whose telephone number is 703-306-0542.

The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM TROST can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "danh", is written over a horizontal line. A diagonal line extends upwards and to the right from the end of the signature.

July 26, 2004

DANH CONG LE
PATENT EXAMINER